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OFFICE OF PETITIONS

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins CO 80527-2400

In re Application of :
John R. Milton :
Application No. 09/938,465 : DECISION ON RENEWED PETITION
Filed: August 23, 2001 : UNDER 37 C.F.R. §1.181(A)
Attorney Docket Number: :
10010979-1 :
Title: SYSTEM AND METHOD FOR :
TRACKING PLACEMENT AND USAGE OF :
CONTENT IN A PUBLICATION :

Background

This is a decision on the renewed petition under 37 CFR §1.181(a), filed May 1, 2006, to withdraw the holding of abandonment.

The request to withdraw the holding of abandonment is **DENIED**[1].

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR §1.113 in a timely manner to the final Office action mailed April 21, 2005, which set a shortened statutory period for reply of three (3) months. An after-final amendment was received on May 25, 2005, and an advisory action was mailed on June 13, 2005. No further responses were received, and no extensions of time under the provisions of 37 CFR §1.136(a) were obtained. Accordingly, the above-identified application became abandoned on July 22, 2005. A notice of abandonment was mailed on December 23, 2005.

The original petition was submitted on January 24, 2006, and was dismissed via the mailing of a decision on March 9, 2006. With

1 This decision may be regarded as a final agency action within the meaning of 5 U.S.C. §704 for the purposes of seeking judicial review. See MPEP 1002.02.

the present petition pursuant to 37 C.F.R. §1.181(a), Petitioner has again failed to establish that the holding of abandonment should be withdrawn. A discussion follows.

The Relevant Law and Regulations

35 U.S.C. 133: Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

37 C.F.R. §1.2: Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

§ 1.113: Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

[24 FR 10332, Dec. 22, 1959; 46 FR 29182, May 29, 1981; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1,

2003; para. (a) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 1.135: Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

[Paras. (a), (b), and (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d) deleted, 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

Analysis

With the original petition, Petitioner asserted that he did not believe that any action needed to be taken after receiving the advisory action which was mailed in response to an after-final amendment, due to a telephone conversation he had with the Examiner. Petitioner asserted that he was informed over the phone that a new office action would be forthcoming - and thus he "took no further action in the case[2]," relying on this oral understanding.

In short, Petitioner decided it best to discount the advisory action, based on an understanding he had with the Examiner. The original petition was dismissed via the mailing of a decision on March 9, 2006, since 37 C.F.R. §1.2 prohibits reliance on an oral assurance which was made by the Examiner.

Since the mailing of this decision, the Examiner has introduced an interview summary into the record, where a conversation which took place more than 6 months prior is memorialized. With this renewed petition, Petitioner would have the Office grant his

2 Original petition, paragraph 8.

request and withdraw the holding of abandonment, as this interview summary constitutes "written evidence of record[3]."

It is noted in passing that this interview summary indicates that the Examiner would issue a new office action, but nowhere is it stated that the final Office action would be withdrawn.

The failure to submit a response

As described above, Petitioner received a final Office action, submitted an after-final amendment, and received an advisory action in response thereto. Petitioner then spoke with the Examiner and received an oral assurance that a new office action would be forthcoming. 35 U.S.C. §1.113(c) clearly states that the proper response to a final rejection must include either the cancellation or appeal from the rejection of each rejected claim, and that if any claims stand allowed, the reply to the final rejection must comply with any requirements or objections to form. Put simply, a reply to a final rejection must consist of some form of a response. However, Petitioner did not submit any response, as he decided against taking any further action.

Petitioner will note U.S.C. §133 is a self-executing law, which indicates that upon the failure of the applicant to prosecute the application within six months after any action therein, the application shall be regarded as abandoned by the parties thereto. Petitioner received an advisory action, and did not continue the prosecution of this application. As such, the application went abandoned by operation of law, and it would be improper for this Office to withdraw the abandonment.

Petitioner will further note that 37 C.F.R. §1.135 is a self-executing regulation which indicates that the failure to reply within the time period provided under 37 C.F.R. §§1.134 and § 1.136 will result in the abandonment of the application. Furthermore, Petitioner did not further prosecution of this application to save the same from abandonment, as no reply was submitted in response to the advisory action. As such, the application went abandoned by operation of law, and it would be improper for this Office to withdraw the abandonment.

The reliance on an oral assurance

The decision on the original decision dismissed Petitioner's request to withdraw the holding of abandonment, on the grounds that Petitioner's reliance on an oral promise is expressly prohibited by 37 C.F.R. §1.2. With the

3 Renewed petition, page 1.

introduction of this oral understanding into the record via the interview summary, nothing has changed. This information was not placed into the record until more than six months after Petitioner's reliance. At the time of Petitioner's reliance, the understanding was a mere oral promise. This section of the C.F.R. expressly prohibits Petitioner's reliance on the oral understanding, and withdrawal of the holding of the abandonment based on an action which is in contravention to a regulation would be improper.

Furthermore, it is noted that the interview on which this interview summary is based took place on November 10, 2005, which is subsequent to the date on which the present application became abandoned (July 22, 2005). Petitioner cannot rely on this interview summary, for an Examiner no longer has jurisdiction over an application once an application becomes abandoned.

CONCLUSION

The prior decision which refused to withdraw the holding of abandonment under 37 C.F.R §1.181(a) has been reconsidered. For the above stated reasons, the holding of abandonment will not be withdrawn.

As stated in the previous decision, no further reconsideration or review of this matter will be undertaken.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

Charles Pearson
Director
Office of Petitions
United States Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,465	08/23/2001	John R. Milton	10010979-1	4080

7590 04/24/2006

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER	
CORRIELUS, JEAN M	

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

notice mailed by the Office on December 23, 2005 be withdrawn and that the prosecution of the application be resumed.

2. Submitted herewith is:

- ☐ A copy of the page of the response mailed _____ showing a Certificate of Mailing executed on _____.
- ☐ A copy of the post card identifying the papers filed and showing the USPTO receipt stamp dated _____.
- ☐ A copy of the complete response previously filed.
- ☐ A copy of the attorney's Deposit Account Statement in which the item corresponding to the response referred to above is checked.
- ☐ A statement of facts as set forth in the 37 CFR 1.181(b).
- ☒ Interview Summary mailed on April 24, 2006.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally, please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of Code of Federal Regulations that may regulate fees.

Respectfully submitted,

Michael J. D'Aurelio

Michael J. D'Aurelio
Registration Number: 40,977

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(770) 933-9500

CERTIFICATION UNDER 37 CFR 1.8

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted on the date indicated below via facsimile to the United States Patent and Trademark Office facsimile number (571) 273-8300. Total number of pages in this transmission 8.

5/1/2006
Date

Gloria L. Knox

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: John R. Milton
Application No.: 09/938,465
Filed: August 23, 2001
Title: SYSTEM AND METHOD FOR TRACKING PLACEMENT AND USAGE OF CONTENT IN A PUBLICATION

Confirmation No.: 4080
Group Art Unit: 2162
Examiner: Cornelius, J.
Docket No. 10010979-1

RENEWED PETITION UNDER 37 C.F.R. §1.181

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

1. On March 9, 2006, a Decision was rendered denying a petition filed in the above-identified patent application to withdraw the holding of abandonment. In particular, the Decision noted that the written record did not reflect the oral promise of the Examiner in the above-identified case to render a new Office Action and that any reliance by the Applicant on such oral promises were misplaced as all business must be conducted in writing.

Applicant respectfully renews the Petition to Withdraw the Holding of Abandonment under 37 C.F.R. §1.181 as the record now includes an Interview Summary that evidences the promise that was made during conversations between the Examiner and the undersigned that the Examiner would issue a new Office Action in the case after issuing the Advisory Action of June 13, 2005. Attached is a copy of the Interview Summary in the above-identified application that states the amendment of May 25, 2005 would be considered and that a new Office Action would be forth coming.

In this respect, Applicant restates the facts and arguments presented with the petition filed on January 24, 2006. In view of the written evidence of record in the above-identified application, Applicant respectfully requests that that the abandonment set forth in the

Interview Summary	Application No. 09/938,485	Applicant(s) MILTON, JOHN R.
	Examiner Jean M. Corrielus	Art Unit 2162

All participants (applicant, applicant's representative, PTO personnel):

(1) Jean M. Corrielus. (3)____.

(2) Michael D'Aurelio (reg. no. 40,977). (4)____.

Date of Interview: 10 November 2005. Case was already abandoned, 711.03

Type: a)☒ Telephonic b)☐ Video Conference
c)☐ Personal [copy given to: 1)☐ applicant 2)☐ applicant's representative]

Exhibit shown or demonstration conducted: d)☐ Yes e)☐ No.
If Yes, brief description: ____.

Claim(s) discussed: 1.

Identification of prior art discussed: ____.

Agreement with respect to the claims f)☐ was reached. g)☒ was not reached. h)☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: It was agreed that the amendment filed on May 25, 2005 will consider and a new office action will be forth coming..

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Jean M. Corrielus
Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record
A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews
Paragraph (b)
In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.
All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:
- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:
1) A brief description of the nature of any exhibit shown or any demonstration conducted,
2) an identification of the claims discussed,
3) an identification of the specific prior art discussed,
4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
6) a general indication of any other pertinent matters discussed, and
7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.